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MICHAEL RODAK, J

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974.

No. 74-463

C. MARSHALL DANN, COMMISSIONER OF PATENTS,
Petitioner,

vs.

HONEYWELL INC.,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR RESPONDENT IN OPPOSITION

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OPINIONS BELOW

The opinion of the Court of Customs and Patent Appeals (App. A. of the Petition, pp. 12-29) is reported at 497 F. 2d 1344. The Opinion of the Trademark Trial and Appeal Board is reprinted at Appendix C of the Petition, pp. 31-39.

JURISDICTION

The jurisdictional requisites are adequately set for in the Petition.

QUESTION PRESENTED

Whether the owner of a trademark is barred from federal registration of his trademark solely because the trademark also appears as a non-functional portion of the subject matter shown in the owner's expired design patent.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, Section 8, clause 8, of the Constitution of the United States provides:

> The Congress shall have Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Section 171 of the Patent Act of 1952, 66 Stat. 805, 35 U. S. C. 171, provides:

> Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

Section 45 of the Lanham Act, 60 Stat. 443, as amended, 15 U. S. C. 1127, provides in pertinent part:

> The term "trade-mark" includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.

STATEMENT

On September 6, 1968, Honeywell Inc. filed an application in the United States Patent Office to register on the Principal Register its trademark (hereinafter referred to as the "Honeywell Round mark") for thermostats. The Honeywell Round mark is a "device"[1] which comprises a non-functional portion of

1. Section 45 of the Lanham Act, 60 Stat. 443, as amended, 15 U. S. C. 1127, states that a trademark "includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others".

the cover of a thermostat, and which was also a portion of the subject matter of a design patent No. 176,657 (R. 20) granted to Honeywell on January 17, 1956 and since expired.

The Trademark Examiner refused to register the Honeywell Round mark on the ground that the specific configuration of the mark was "incapable of performing the trademark function as set forth in the definition of a trademark under Section 45 of the [Lanham] Act" (R. 35). This refusal to register was affirmed by the Trademark Trial and Appeal Board on the ground "that the registration sought by applicant [Honeywell] would extend the monopoly which the applicant [Honeywell] has enjoyed for a period of fourteen years from the issuance of the design patent [No. 176,657]. . . ." (App. C of the Petition, p. 36).

The Court of Customs and Patent Appeals reversed and remanded the case to the Trademark Trial and Appeal Board for its "views on the functionability reasoning relied upon by the examiner. . . ."[2] (App. A of the Petition, p. 24). In reversing the Trademark Trial and Appeal Board, the Court of Customs and Patent Appeals relied on its prior decision, *In re Mogen David Wine Corp.*, 328 F. 2d 925 (C. C. P. A. 1964), wherein the Court had held that:

> "trademark rights, or rights under the law of unfair competition, which happen to continue beyond the expiration of a design patent, do not 'extend' the patent monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other. When the patent monopoly ends, it ends. The trademark rights do not extent it" 328 F. 2d at 930.

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2. Judge Rich, in his concurring opinion, clarified what was meant by the term "functionability reasoning" (App. A of the petition, p. 26).

REASONS FOR DENYING THE WRIT

The question presented is directed to a very specific point of law of limited application and consequence. The resolution of this question will have little, if any, effect on the administration of the patent and federal trademark laws. Contrary to the contention of Petitioner, there is no conflict between the opinion below and the decisions of other courts.

I.

The Question Is of Limited Importance

Over the past decade and a half, the Court of Customs and Patent Appeals has, on a case-by-case basis, been reexploring and defining the metes and bounds of the interface between the patent laws and the federal trademark laws. *E.g., Best Lock Corp.* v. *Schlage Co.*, 413 F. 2d 1195 (C. C. P. A. 1969); *In re Mogen David Wine Corp.*, 372 F. 2d 539 (C. C. P. A. 1967); *In re Shenango Ceramics, Inc.*, 362 F. 2d 287 (C. C. P. A. 1966); *In re Mogen David Wine Corp.*, 328 F. 2d 925 (C. C. P. A. 1964); *In re Deister Concentrator Co.*, 289 F. 2d 496 (C. C. P. A. 1961); and *In re Shakespeare Co.*, 289 F. 2d 506 (C. C. P. A. 1961). While there may be unresolved policy and procedural questions within this general area of interface, the question presented is not especially significant or important among the many that might be posed against the already developed case law.

The question presented is applicable only to a particular, specific set of facts, and the chances of a similar set of facts occurring again in the future are at best limited; if not wholly unlikely. Moreover, even a favorable resolution of the question, from the standpoint of Honeywell, will not be determinative of the registerability of the Honeywell Round mark in view of the unresolved "functionability" question.

The question presented is premature in that it has not as yet been considered by other Courts in the crucible of adversary, inter-parties litigation based upon the issuance and enforcement of such a trademark registration. This Court should await such consideration, assuming that a controversy ever does arise in adversary litigation, before resolving such question as might then be framed. There is certainly no urgency to such consideration. The Court of Customs and Patent Appeals first decided the question presented over ten years ago in *In re Mogen David Wine Corp.*, 328 F. 2d 925 (C. C. P. A. 1964), and merely reaffirmed that decade-old decision in the opinion below.

This Court has previously considered questions relating to the interface between the patent laws and the trademark laws. *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U. S. 225 (1964); *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U. S. 234 (1964); *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U. S. 249 (1945); *Kellogg Co.* v. *National Biscuit Co.*, 305 U. S. 111 (1938); and *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169 (1896). The Court below fully considered these decisions of this Court in its opinion below (App. A of the Petition, pp. 18-24). The opinion below represents no departure from the thrust of these decisions but merely represents a refined application of the principles set forth therein to the specific factual situation involved in this case.

II.

There Is No Conflict of Decision

Petitioner also alleges as grounds for the granting of its Petition that the decision below "directly conflicts" with the decision in *Lucien Lelong, Inc.* v. *Lander Co.*, 164 F. 2d 395 (2nd Cir. 1947) (Petition, p. 6). However, even Petitioner concedes that the *Lucien Lelong* case did not involve a question relating to the interface between the patent laws and

the federal trademark laws (Petition, p. 9). While the *Lucien Lelong* case does include a discussion of the relationship between the patent laws and common law trademark rights, this discussion is dictum. *Lucien Lelong, Inc.* v. *Lander Co., supra,* 164 F. 2d at 397-98. Moreover, the Second Circuit Court of Appeals has recently cited *In re Mogen David Corp.,* 328 F. 2d 925 (C. C. P. A. 1964) with approval. *Bose Corp.* v. *Linear Design Labs, Inc.,* 467 F. 2d 304, 309 (2nd Cir. 1972).

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

Respectfully submitted,

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